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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/903,444	07/09/2001	William H. Barber	394423	9729
30955	7590	12/29/2005		
LATHROP & GAGE LC 4845 PEARL EAST CIRCLE SUITE 300 BOULDER, CO 80301			EXAMINER MCALLISTER, STEVEN B	
			ART UNIT	PAPER NUMBER
			3627	

DATE MAILED: 12/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/903,444

Applicant(s)

BARBER ET AL.

Examiner

Steven B. McAllister

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-41 and 63-71 is/are pending in the application.
- 4a) Of the above claim(s) 63-71 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-41 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Election/Restrictions

Applicant's election with traverse of Group I, claims 1-41, in the reply filed on 10/4/2005 is acknowledged. The traversal is on the ground(s) that:

The examiner should make the requirement as early as possible in the prosecution. The examiner acknowledges that it is beneficial to make the requirement as early as possible. The examiner has tried to do so by making the requirement as soon as the case was transferred to his docket. The examiner also notes, however, that it is proper to make a requirement at any time during prosecution.

Regarding the argument that Group I and Group III should be examined together, because claim 1 is generic with respect to the claims of group III, the examiner acknowledges the argument but respectfully disagrees. It is noted that MPEP 806.04(d) states that a generic claim "should require no material element additional to those required by the species claims, and each of the species claims must require all the limitations of the generic claim". In the present case, the species claims do not require all the limitations of the generic claim. For instance, the proposed species claims recite a plurality of kiosks, while claim 1 recites "one or more" kiosks. The proposed species do not require that the number of kiosks can be one.

The requirement is still deemed proper and is therefore made FINAL.

Claims 63-71 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or

linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 10/4/2005.

Claim Rejections - 35 USC § 112

Claims 12 and 33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 12 recites "the first kiosk and the one kiosk", but it is unclear what "the one kiosk" refers to. In examining the claim, it was assumed to refer to the first kiosk.

Claim 33 is indefinite because it recites at least one of "email or other wireless device". As understood by the examiner an email is not a type of device. It is not clear what is intended by the claimed language.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3, 5, 7, 8, 18, 19, 23,31,32 are rejected under 35 U.S.C. 102(e) as being anticipated by Kanoh et al (5,934,439).

Kanoh et al show kiosks, which dispense CDs (col. 1, lines 7-12), and receives the CDs back. Kanoh et al. shows that the kiosks are connected to a remote host computer 50; (see col. 5, lines 33-40); and show a first kiosk automatically interfacing with a first user in a first transaction for local optical recorded media (e.g., a CD). Kanoh et al. disclose automatic electronic transmission of charges to a credit card company (see col. 4, lines 28-31, 4749, col. 9, lines 43-50 and col. 10, lines 5-12) and dispensing the first local media is the transaction is approved. Kanoh et al. include a reader 61 that reads bar codes on the CDs and indicates when a CD is erroneously returned (it determines if the incorrect title is being returned and it determines if a CD not associated with the sytem is being returned). Kanoh et al. maintain an inventory of the rented CDs and the location of the CDs in the kiosk; (see col. 7, lines 35-64).

As to claims 2 and 8, Kanoh shows returning the CD to a second kiosk comprising the first kiosk.

As to claims 5 and 7, Kanoh shows capturing a second code on the first optical medium and scanning the image to determine a disk identifier (the second code comprising a second portion of the bar code containing this information).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4,6 rejected under 35 U.S.C. 103(a) as being unpatentable over Kanoh et al.

As to claims 4 and 6, Kanoh et al show all elements except rotating the image via internal software and rescanning to determine the information in the code. However, the examiner takes official notice that it is notoriously old and well known to rotate an image via internal software and rescan in order to determine the information in the code. It would have been obvious to one of ordinary skill in the art to modify the method of Kanoh et al by doing so in order to more reliably scan the bar code when the orientation is askew.

Alternatively, as to claims 5 and 7, Kanoh et al show all elements except capturing a first and second code in order to capture the group identifier and the disk identifier. However, it would have been an obvious matter of design choice to modify the method of Kanoh et al by scanning two bar codes (instead of one as in Kanoh) to determine the group identifier and disk identifier, since the application does not disclose that storing and scanning the information in two separate codes solves a particular problem or is for any particular purpose.

As to claims 9-11, Kanoh et al show all elements of the claim except sensing characteristics of a case housing the medium, the characteristics comprising one or more holes or blocked regions on the case, and determining if the characteristics match predetermined characteristics. However, it would have been an obvious matter of design choice to modify the method of Kanoh et al by sensing characteristics of a case

housing the medium, the characteristics comprising one or more holes or blocked regions on the case, and determining if the characteristics match predetermined characteristics. It would have been obvious to one of ordinary skill in the art to modify the method of Kanoh by doing so in order to determine whether to initially accept the medium without removing the case and risking damage.

As to claim 12, Kanoh et al show all elements except that inventory tracking is accomplished at the central server. However, the examiner takes official notice that it is notoriously old and well known in the art to provide inventory tracking at a central server. It would have been obvious to one of ordinary skill in the art to do so in order to facilitate backup of the inventory information and in order to enable integrated tracking of the entire inventory of the system of kiosks.

As to claims 13-15, Kanoh et al show all elements except imaging a user interacting with the kiosk. However, the examiner takes official notice that it is notoriously old and well known in the art to do so. It would have been obvious to one of ordinary skill in the art to modify the method of Kanoh by imaging a user interacting with the kiosk in order to provide security information.

As to claims 13-16, Kanoh et al show all elements except imaging a user conducting a user identification or credit card input at the kiosk. However, the examiner takes official notice that it is notoriously old and well known in the art to do so. It would have been obvious to one of ordinary skill in the art to modify the method of Kanoh by imaging a user conducting a user identification or credit card input at the kiosk in order to provide security information.

As to claims 13 and 17, Kanoh et al show all elements except imaging and providing the information to the server. However, the examiner takes official notice that it is notoriously old and well known in the art to do so. It would have been obvious to one of ordinary skill in the art to modify the method of Kanoh by imaging and providing the information to the server in order to provide security information and in order to store the information in a secure location.

As to claims 20-22, Kanoh et al show all elements of the claims except providing advertising information to a third kiosk, the information displayed on a screen and audibly communicated. However, the examiner takes official notice that it is notoriously old and well known in the art to do so. It would have been obvious to one of ordinary skill in the art to modify the method of Kanoh by providing advertising information to a third kiosk, the information being displayed on a screen and audibly communicated in order to entice potential customer, attract new business, and to "push" certain products.

As to claims 24 and 25, Kanoh et al show all elements of the claims except profiling a customer at a fourth terminal and providing advertising information based on user profile. However, the examiner takes official notice that it is notoriously old and well known in the art to do so. It would have been obvious to one of ordinary skill in the art to modify the method of Kanoh by profiling a customer at a fourth terminal and providing advertising information based on user profile in order to better target advertisements.

As to claims 26-29, Kanoh et al show all elements except managing advertisements or inventory via a personal computer connected to the internet.

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However, the examiner takes official notice that it is notoriously old and well known in the art to do so. It would have been obvious to one of ordinary skill in the art to modify the method of Kanoh by managing advertisements or inventory via a personal computer connected to the internet in order to allow managing remote from the server, and in order to provide for changing and optimizing of advertising or determining inventory as new products are released and old ones retired.

As to claim 30, 38 and 39, Kanoh et al in view of the old and well known prior art show all elements except sending a coupon based on inventory of the kiosk. However, the examiner takes official notice that it is notoriously old and well known in the art to do so. It would have been obvious to one of ordinary skill in the art to further modify the method of Kanoh by sending a coupon via email to a customer based on inventory in order to stimulate rentals of overstocked items.

As to claim 33, Kanoh et al show all elements of the claim except communicating at least one of a voice or text message to the administration by at least one of a mobile phone, pager, email or other wireless device. However, the examiner takes official notice that it is notoriously old and well known in the art to do so. It would have been obvious to one of ordinary skill in the art to modify the method of Kanoh by communicating at least one of a voice or text message to the administration by at least one of a mobile phone, pager, email or other wireless device in order to allow explicit and unambiguous message to be sent, rather than just alarm signal via speaker 51 of Kanoh.

As to claims 38-40, Kanoh et al show all elements of the claim except distributing a coupon to users of the first kiosk activated by a transaction at the kiosk. However, the examiner takes official notice that it is notoriously old and well known in the art to do so. It would have been obvious to one of ordinary skill in the art to modify the method of Kanoh by distributing a coupon to users of the first kiosk activated by a transaction at the kiosk in order to increase rentals by targeting users of the system.

As to claim 41, Kanoh et al show all elements of the claim except that the remote administration takes place via a web interface. However, the examiner takes official notice that it is notoriously old and well known in the art to do so. It would have been obvious to one of ordinary skill in the art to modify the method of Kanoh by managing the system via a remote web interface in order to allow management of the system from different locations without the installation of dedicated communications infrastructure for the managing.

Response to Arguments

Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven B. McAllister whose telephone number is (571) 272-6785. The examiner can normally be reached on M-Th 8-6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander G. Kalinowski can be reached on (571) 272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Steven B. McAllister

Steven B. McAllister
Primary Examiner
Art Unit 3627

STEVE B. McALLISTER
PRIMARY EXAMINER